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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,806	02/27/2004	Chu Yih Yu	251309-1040	7849

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EXAMINER

VERBITSKY, GAIL KAPLAN

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

**Office Action Summary**

Application No.

10/788,806

Applicant(s)

YU, CHU YIH

Examiner

Gail Verbitsky

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-13, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/27/2004</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8-13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. 6402182) in view of Denebeim (U.S. 5479951).

Chen discloses in Figs. 1-2 a deflectable thermometer probe comprising a bendable probe body 20, a hollow tip member secured to the bendable probe body and having a thermal contact surface 121 containing a thermal sensor mounted inside the thermal contact surface for sensing temperature of the thermal contact surface and thus, temperature of an object of interest, a set of lead wires, as shown in Fig. 1, a deflectable member (joint) having a main part disposed in the bendable probe body. The deflectable member is bent by force and does not necessarily return in its original position when the force is removed, therefore, it is, along with the bendable probe body, is sustained in a bent form.

Chen does not teach that the bendable body having a hollow pipe, and that the bending of the main portion of the deflectable member is done by deformation.

Denebeim discloses in Figs. 2, 3, 6 a device comprising a bendable probe body having a hollow plastic tube/ pipe 32. As shown in Fig. 2, the bendable probe body is inserted into a tip; this would imply that the tip 24 is a hollow tip secured to the body.

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The device also comprises a main portion of a deflectable member (bending element) 34 which is a soft metal that is flexible enough that it can be easily bent to the desired position but rigid enough that will hold the desired position after it has been bent. (col. 3, lines 12-42).

For claim 4: As shown in Fig. 2, there is a space formed between the hollow pipe 32 and the main portion of the deflectable member 34 allowing deformation of the main portion of the deflectable member 34.

For claim 2: the deflectable member is a deflectable soft metal wire.

For claim 3: the hollow pipe of Denebeim has a portion with a diameter greater than the diameter of the main portion of the deflectable member.

For claim 16: the particular diameter of the deflectable metal wire, i.e., from 0.5 mm to 2.0 mm, absent any criticality, is only considered to be the "optimum" diameter of the wire used by Denebeim for the deflectable member that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the diameter of the bendable probe body, etc. **See *In re Boesch*, 205 USPQ 215 (CCPA 1980).**

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the deflectable member main portion of the device disclosed by Chen with the deflectable member main portion, as taught by Denebeim, so as to increase the angle of deformation/ bending, in order to allow more convenient use of the device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Chen, so as to have a bendable hollow pipe around the joint, as taught by Denebeim, so as to cover the joint

and to allow it to move any degree of freedom, in order to allow more convenient use of the device.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denebeim (U.S. 5479951).

Denebeim discloses in Figs. 2, 3, 6 a device comprising a bendable probe body having a hollow plastic tube/ pipe 32. As shown in Fig. 2, the bendable probe body is inserted into a tip; this would imply that the tip 24 is a hollow tip secured to the body. The device also comprises a main portion of a deflectable member (bending element) 34 which is a soft metal that is flexible enough that it can be easily bent to the desired position but rigid enough that will hold the desired position after it has been bent. (col. 3, lines 12-42). As shown in Fig. 2, there is a space formed between the hollow pipe 32 and the main portion of the deflectable member 34 allowing deformation of the main portion of the deflectable member 34.

With respect to the preamble of claim 17: the preamble of the claims does not provide enough patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and a portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

***Allowable Subject Matter***

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3. Claims 6-7 and 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

Gail Verbitsky

Primary Patent Examiner, TC 2800



February 16, 2005